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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,992	05/03/2001	Wilfried Lubisch	49500	7169

26474            7590            03/13/2003

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STOCKTON, LAURA

ART UNIT	PAPER NUMBER
1626	JL

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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16

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on March 4, 2003

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1 - 26 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) 1 - 26 is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
 The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
 All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

## **DETAILED ACTION**

**Claims 1-26 are pending in the application.**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 4, 2003 has been entered.

Rejections made in the previous Office Action which do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the original filed claims can be found for R<sup>2</sup> representing “NR<sup>22</sup>R<sup>23</sup>” in claims 1-3. Therefore, the claims lack written description as such.

***Response to Arguments***

With respect to the definition of R<sup>2</sup> representing NR<sup>22</sup>R<sup>23</sup> in claim 1, Applicants argue that an obvious typographical error has been

corrected and therefore, the rejection of the claims under 35 USC 112, first paragraph should be withdrawn. In response, support in the specification (page 8, line 19) and the originally filed claims (page 59, line 34) can be found for R<sup>2</sup> representing NR<sup>21</sup>R<sup>22</sup> but not NR<sup>22</sup>R<sup>23</sup>. Therefore, the claims lack written description as such.

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The structures of formula I and formula II in claim 1 are illegible.

Claim 1 states that “K is a phenyl which may carry at most two radicals R, is NR<sup>k1</sup>R<sup>k2</sup>.....”. This definition of the K variable in claim 1 is confusing. The variable R is not defined and it is unclear for what

purpose  $NR^{k1}R^{k2}$  is needed. It is not clear if K represents a radical other than phenyl (such as the radicals starting at "NH-C<sub>1</sub>-C<sub>4</sub>-alkylphenyl") or if the radicals starting at "NH-C<sub>1</sub>-C<sub>4</sub>-alkylphenyl" are possible substituents on the phenyl ring or if the radicals starting at "NH-C<sub>1</sub>-C<sub>4</sub>-alkylphenyl" are also defining R<sup>k1</sup> and R<sup>k2</sup>.

In claims 1-3, an "or" should be added before the last substituent listed under the definitions for the variables G, R<sup>52</sup> (also the possible substitutable substituents), B and R<sup>5</sup>. Further, in claims 1-3, some of the structures under the definitions of G, B and R<sup>5</sup> are illegible.

In claims 2 and 3, under the definition of R<sup>51</sup>, the phrase "hydrogen and branched" should be changed to "hydrogen or branched".

In claim 2, under the definitions of R<sup>52</sup> and R<sup>53</sup>, the phrase "and two radicals form a bridge -O-(CH<sub>2</sub>)<sub>1,2</sub>-O-" should be changed to "or two radicals form a bridge -O-(CH<sub>2</sub>)<sub>1,2</sub>-O-" (see the third and fourth lines from the end of claim 2).

Claims 2 and 3 contain variables and substituents that lack antecedent basis from claim 1. See in claim 2, for example, the definition of R<sup>3</sup> (e.g., R<sup>31</sup>, m, n, etc.).

In claim 3, an “or” should be added before the last substituent listed under the definition of R<sup>3</sup>.

In claim 3, under the definition of R<sup>52</sup>, the substituents “COCH<sub>3</sub>” and “COCF<sub>3</sub>” lack antecedent basis from claim 1.

In claim 6, an “or” should be added after “NH<sub>2</sub>”.

Claim 7 lacks antecedent basis from claim 1 because of the definitions of R<sup>3</sup> and R<sup>31</sup>, and its definitions, etc. {e.g. R<sup>3</sup> is either “-D-(F<sup>1</sup>)<sub>p</sub>-(E)-<sub>q</sub>-(F<sup>2</sup>)<sub>r</sub>-G” or “-E-(D)<sub>u</sub>-(F<sup>2</sup>)<sub>s</sub>-(G)<sub>v</sub>” in claim 1}.

In claim 8, D representing “0” lacks antecedent basis from claim 1.

In claim 23, it would appear that “I thereof” should be changed to “thereof”.

*Response to Arguments*

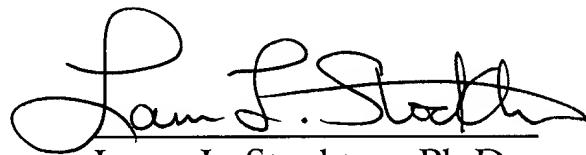
Applicants' arguments filed March 4, 2003 have been fully considered but they are not persuasive. Applicants argue that the definition of K in claim 1 has been amended to conform with the original wording of the originally filed claims and therefore, the rejection under 35 USC 112, second paragraph as it regards the definition of K should be withdrawn. In response, the language in the definition of the K variable, as originally filed, was also rejected under 35 USC 112, second paragraph {see the Office Action dated August 21, 2001– Paper No. 5, page 7, r)}.

Applicants argue that the definitions of R<sup>3</sup> in claims 2, 3 and 7 have antecedent basis from claim 1. Applicants argue that the definitions of R<sup>3</sup> in claims 2, 3 and 7 are derived from the R<sup>3</sup> definition of claim 1. In response, R<sup>3</sup> in claim 1 is defined as “-D-(F<sup>1</sup>)<sub>p</sub>-(E)-<sub>q</sub>-(F<sup>2</sup>)<sub>r</sub>-G”, “-E-(D)<sub>u</sub>-(F<sup>2</sup>)<sub>s</sub>-(G)<sub>v</sub>” or B. The claims lack antecedent basis since, for example, in claim 2, variables m, n and o are not present in claim 1. Therefore, the rejection is proper and maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.



Laura L. Stockton, Ph.D.

Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

March 12, 2003